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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,108	09/29/2003	Thomas R. Goecke	GOEC 2 00001	2438

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EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,108

Applicant(s)

GOECKE, THOMAS R.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/24/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 the phrase "said first polymer" is found to be indefinite for lack of antecedent basis.

Claim 2, the phrase "said second layer" is deemed to be indefinite for lack of antecedent basis. It is not clear as to which layer is referred to by said phrase.

Claims 8 and 9, the phrase "said first layer" is found to be indefinite for lack of antecedent basis. It is unclear as if said phrase refers to a layer that is different from the "first polymer layer" as recited in claim 1 or not.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Condon (5686170).

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Condon relates to an adhesive tape comprising a polymer layer (12) such as polyvinyl chloride having a Shore hardness of greater than 65 and a layer of adhesive (30) attached to the first polymer layer (assumed by the examiner to be the polyvinyl chloride layer). The tape has a substrate (26) attached to the outermost side of the second layer (which is assumed by the examiner to be the adhesive layer). As mentioned above, the polymer layer comprises polyvinyl chloride (PVC), including a textured surface (col. 5, lines 40-54). The polymer layer includes coloring pigment (col. 5, lines 55-60). The PVC (12) layer can be clear or transparent (col. 5, lines 40-42) and has a thickness of 0.001 to 0.025 inches (col. 5, lines 24-26). The adhesive can be pressure sensitive adhesive (PSA) (col. 6, lines 60-61) and the adhesive layer is known to exhibit double-sided adhesive tape.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Ungar (6440538).

Ungar relates to an adhesive tape comprising a base layer (10) of polyvinyl chloride (PVC) having a Shore hardness of 50 –100 (col. 7, lines 47-54) and a layer of adhesive (9) attached to said layer (10). A top wear resistant layer (5) is attached to the outermost side of the adhesive layer. The adhesive can be rubberized pressure sensitive adhesive and is a double-sided adhesive tape because the adhesive layer would have two adhesive surfaces on opposite sides thereof. The base layer includes

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fillers, additives, carbon black, etc. (col. 7, lines 64-67) which would provide for a textured surface and impart color thereto as desired. The thickness of the PVC can be 2.4 mm.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Condon in view of Ungar.

Condon, as discussed above, fails to teach that the PSA can be rubberized. Ungar, also discussed above, teaches the advantage of using rubberized PSA for providing adhesion compatibility between the layers and for its waterproof property (col. 8, lines 14-19). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Ungar's teaching of using rubberized PSA as the adhesive layer in the invention of Condon with the motivation to provide for waterproof property when attached to a surface and its adhesive compatibility for durable adhesion.

Information Disclosure Statement

8. The references cited in the IDS submitted on August 24, 2004 have been considered except for the article titled "High Quality Tapes and Labels" for lack of its

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published date. Hence, the article has been penciled out in the attached PTO-1449 form.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
March 16, 2005.